

PATENTMS160276.1 / MSFTP169USRemarks

Claims 1-48 are currently pending in the subject application and are presently under consideration. A new listing of the claims is at pages 2-10. Claims 32 and 40 have been amended herein. Claims 13-15, 17, 25 and 39 have been corrected to remove text that was previously indicated as stricken but inadvertently left in the claim. The claims now conform to the rules for amendment practice. No new matter has been added.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claims 40-48 Under 35 U.S.C. §112, Second Paragraph**

Claims 40-48 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Withdrawal of this rejection is requested in view of the amendment to claim 40.

**II. Rejection of Claims 1-40, 42 and 45-48 Under 35 U.S.C. §102(b)**

Claims 1-40, 42 and 45-48 stand rejected under 35 U.S.C. §102(b) as being anticipated by Jones *et al.* (U.S. 5,666,501). Applicants' representative respectfully requests withdrawal of this rejection for at least the following reasons. Jones *et al.* does not teach or suggest each and every limitation recited in the subject claims.

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described in a *single prior art reference*." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987) *Emphasis added*. "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants' invention provides a software tool and methodology for installing an operating system or other program onto a computer system. The software tool queries or senses the value of a registry key and selectively modifies the installation according to

PATENTMS160276.1 / MSFTP169US

the sensed attribute. Based on the value of the registry key, one or more setup screens or prompts may be selectively rendered or suppressed from being rendered to the user via an interface. In addition, the software tool may selectively prompt a user for a setup-related choice or use an unprompted default setup value associated with one or more setup options according to the sensed attribute. Where a setup screen is adapted to prompt the user for a first or second choice, and the registry key value indicates that the second choice is invalid for the computer system, the software tool may selectively use the first choice in installing or setting up the operating system, and may further selectively suppress the rendering of the setup screen to the user. In this way, the user is presented with an automated logical setup prompt flow tailored to the specific system in which the setup is occurring. Thus, where an operating system or other program is being installed in a system having an application suite which renders one or more of the operating system setup choices inapplicable or otherwise invalid, the software tool can easily sense an attribute, such as a registry key, indicating the installed application suite package, and customizes the operating system installation prompting accordingly.

In particular, claim 1 recites in part that the software component includes ...a setup component that *senses an attribute of a registry*...which attribute is associated with a low functionality suite package and a higher functionality suite package... Moreover, ...a user interface component...renders a plurality of *setup prompts* to a user and obtains a user command... The software tool then ...selectively provides at least one *setup prompt* to the user interface component according to the attribute, and selectively installs the software component on the computer system according to the user command... Jones *et al.* does not teach or suggest such claimed features of applicants' invention.

Rather, Jones *et al.* teaches a method, apparatus, and memory for installing software stored on a second machine to a first machine in a distributed computing environment. A graphical user interface (GUI) provides numerous selectable options that enable a user to manually select the software from various source media (local and/or remote) and to manually choose from software bundles of a selected source media. All or part of the software of a selected bundle can also be manually chosen by the user for install. The GUI also includes display controls that allow the user to manually control and manipulate a software item in a panel of software items presented for installation.

PATENTMS160276.1 / MSFTP169US

It is readily apparent that Jones *et al.* neither teaches nor suggests a software tool that senses a registry attribute related to such low functionality suite package and higher functionality suite package as in the claimed invention. The Examiner incorrectly contends that it is inherent that a setup component is adapted to sense an attribute of a registry associated with the computer system. The registry is a database of configuration settings in a Windows-brand operating systems that stores configuration data about the hardware/software environment of the computer in which the operating system or application has been installed. Jones *et al.* does not teach or suggest a registry or a registry key.

Furthermore, Jones *et al.* does not teach accessing a registry or registry key for installation of the software, rather simply provides a GUI that presents numerous options that must be selected by the user for loading software from the remote computer to the local computer. The subject invention accesses the registry such that installation processes are more fully automated with limited user interaction by way of the prompts. Registry access facilitates background decision-making and processing by the software tool such that based on the registry information, the software tool provides *...a setup component that senses an attribute of a registry* and *...selectively provides at least one setup prompt...according to the attribute...* It is automated - the user need only respond to the selectively provided prompts for the installation to proceed.

The Examiner incorrectly equates a portion of the subject claim limitation of setup prompts with the step of displaying software bundle objects of software items, in Jones *et al.* The cited reference does not teach or suggest prompts as understood in the art, but simply presents all of the installation options to the user such that user interaction is required for all aspects of the installation to occur. To wit, once the user selects only one source object (FIG. 2, panel 210), from many source objects, the GUI presents the software bundles associated with the source object. Whether a single bundle or multiple bundles, the user then selects only one software bundle (FIG. 2, panel 220). Thereafter, the GUI can then present the software files in that bundle (FIG. 2, panel 240), and from which the user can select all or a portion of the files for installation. The user can scroll through the list of files provided in panel 240 and select files for installation. Thus, in contrast to applicants' claimed invention, Jones *et al.* teaches that the user must manually

PATENTMS160276.1 / MSFTP169US

make software and/or file selections from a plurality of presented options in order for the installation to occur.

The Examiner references col. 3, lines 28-37, of Jones *et al.* which states "...a given bundle can be either a subset or a superset of a particular source object, depending on whether all the software items listed in the bundle are available on the particular source object." Additionally, the Examiner further indicates that "...in order to display a setup prompt to the user interface component, the setup component has to access the registry in order to find out information of the components that are installed already or of the components that are not installed." Jones *et al.* neither teaches nor suggests that any of the source objects, software bundles for the source objects, or items of the bundles are presented by the GUI as a result of accessing a registry or attribute thereof, as recited in the claim limitations.

Limitations similar to that of claim 1 are also recited in independent claims 14, 21, 28, 35, 39, and 40.

As recited in claim 14, the software installation is performed using ...a setup component *senses an attribute of a registry...which attribute is associated with a low functionality suite package and a higher functionality suite package...* . The setup component ...selectively provides one of *standard prompting and special prompting to a user according to the attribute...* .

Regarding claim 21, the setup operation method is performed by ...*sensing an attribute of a registry...which attribute is associated with a low functionality suite package and a higher functionality suite package...* selectively providing one of *standard prompting and special prompting to a user according to the attribute...* .

Likewise, claim 28 recites that the setup is performed by ...*sensing an attribute of a registry...which attribute is associated with a low functionality suite package and a higher functionality suite package...* selectively providing one of *standard prompting and special prompting to a user according to the attribute...* .

In claim 35, the software tool setup operation is performed using ...means for *sensing an attribute of a registry...which attribute is associated with a low functionality suite package and a higher functionality suite package...* and means for

PATENTMS160276.1 / MSFTP169US

selectively providing one of *standard prompting and special prompting to a user according to the attribute...*

Regarding claim 39, data packets are transmitted between two server processes, which include a setup component that *...senses an attribute of a registry...which attribute is associated with a low functionality suite package and a higher functionality suite package...and selectively provides one of standard prompting and special prompting to a user according to the attribute...*

New claim 40 recites similar limitations for installation of a *server operating system*, which includes a set component that *...senses an attribute of a registry...and provides...at least one of standard prompts for loading a standard functionality installation of server components and special prompts for loading a special lower functionality installation of server components...*

The many dependent claims, a few of which are addressed herein, recite additional limitations neither taught nor suggested by Jones *et al.*

For example, claim 2 recites *...the setup component selectively suppresses at least one setup prompt from the user interface component if the attribute indicates the at least one setup prompt is unnecessary.* Jones *et al.* neither teaches nor suggests suppression of a prompt. Furthermore, Jones *et al.* does not teach or suggest suppression of a prompt based on the attribute of the registry as in the subject claim.

Claim 3 recites *...the at least one setup prompt comprises a selection between at least two setup parameters, and the setup component selects one of the at least two setup parameters according to the attribute.* In contrast, Jones *et al.* teaches that the user makes the selection, and not according to an attribute of a registry.

Claim 6 recites *...the data comprises a registry key.* The Examiner again states that "it is inherent that a setup component is adapted to sense an attribute of a registry associated with a computer system." Jones *et al.* neither teaches nor suggests a registry key, let alone a registry. The GUI of Jones *et al.* simply presents the contents of source objects that can be optionally selected by a user for installation. Presentation of such objects would not require registry access, but simply scanning of the contents of the source object(s), the included software bundle(s), and items therein.

PATENTMS160276.1 / MSFTP169US

In view of at least the foregoing comments, it is respectfully submitted that the subject independent claims and those that depend therefrom are neither anticipated nor suggested by Jones *et al.*, and that this rejection should be withdrawn.

**III. Rejection of Claims 41, 43 and 44 Under 35 U.S.C. §103(a)**

Claims 41, 43 and 44 stand rejected under 35 U.S.C. §103(a) as being unpatentable by Jones *et al.* in view of Kenner *et al.* (U.S. 6,314,565).

Applicants' representative respectfully requests withdrawal of this rejection for at least the following reasons. The subject claims depend from independent claim 40. Kenner *et al.* fails to make up for the aforementioned deficiencies of Jones *et al.* with respect to this independent claim. Moreover, the references themselves do not provide a requisite basis for suggesting or motivating the Examiner's purported combination.

"[i]t is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, **in the prior art**, to combine the elements." *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997) (emphasis added). Moreover, that such elements may have co-existed individually for an extended period of time, but never combined in the manner claimed actually supports a conclusion of **non-obviousness**. *Id.*

As recited in dependent claim 41, ...the standard functionality installation includes the rendering of a standard prompt that is a licensing page, ***which licensing page is not rendered during the special lower functionality installation.*** Kenner *et al.* neither teaches nor suggests such a limitation.

Dependent claim 43 further depends from claim 42, and recites ...the ***per server mode invokes a fixed number of client user licenses.*** Kenner *et al.* neither teaches nor suggests such a limitation.

Claim 44 depends from independent claim 40, which Applicants' representative submits is not obvious in view of the arguments set forth above.

In view of the aforementioned deficiencies of Kenner *et al.* and because the requisite teaching or suggestion to combine the elements in the manner suggested is

PATENTMS160276.1 / MSFTP169US

absent from the cited references, it is respectfully submitted that this rejection be withdrawn.

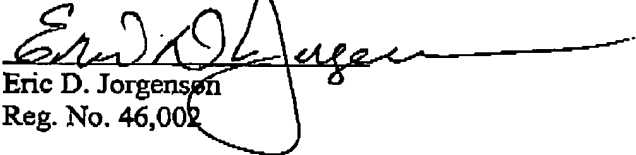
CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,  
AMIN & TUROCY, LLP

  
Eric D. Jorgensen  
Reg. No. 46,002

AMIN & TUROCY, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731